<center>REMARKS</center>

The Final Office Action, mailed March 14, 2007, considered claims 1–13 and 25. Claims 1–13 and 25 were rejected under 35 U.S.C. § 102(b) as being anticipated by Shuman, U.S. Patent No. 6,424,995 (filed Aug. 13, 1998) (hereinafter Shuman).[1]

By this response, no claims are amended and claim 27 is newly presented. Claims 1–13, 25, and 27 remain pending. Claims 1 and 25 are independent claims which remain at issue. Support for the newly presented claim may be found within Specification ¶¶ 59 and Figure 1.[2]

As reflected in the claims, the present invention is directed generally towards methods and products for efficiently and reliably providing message related data. Claim 1, for instance, in combination with all the elements recited in the claim, is a method whereby an operating system receives a registration request from a message application, the operating system determines that a folder silo has resources available to satisfy the registration request and allocates space within the folder silo for the request, and then maintains an indication that the message application has control of the folder space so that other message applications can be made aware that the application has control. Claim 25 recites, in combination with all the claim's elements, a computer program product implementing a method similar to that specified in claim 1.

Shuman, cited in the 35 U.S.C. § 102 rejection of both claims 1 and 25, however, teaches generally a method for displaying information contained in an electronic message.[3] More particularly, Shuman teaches displaying information concerning electronic messages which is automatically derived by examining message properties corresponding to defined test properties.[4] Shuman composes information items in natural language which reflect the state of the message and then prioritizes and displays the composed information.[5] Unlike the present invention, Shuman is

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[1] Although the prior art status of the cited art is not being challenged at this time, Applicants reserve the right to challenge the prior art status of the cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

[2] However, it should be noted that the present invention and claims as recited take support from the entire Specification. As such, no particular part of the Specification should be considered separately from the entirety of the Specification.

[3] *See, generally,* Shuman.

[4] Shuman, Abstract.

[5] *Id.; see also, generally,* Shuman.

not directed, *inter alia*, towards operating systems, registrations, resources, allocation of space, or maintaining an indication of primary control of allocated space.[6]

The Applicants respectfully submit that Shuman does not teach each and every element of the present invention as recited in the claims. In particular, Shuman does not teach an "operating system receiving a folder registration request from a message application."[7] The Examiner cites to Shuman col. 9 l. 44–49 for teaching an operating system *receiving a folder registration request from a message application.*[8] The cited portion of Shuman is reproduced here:

> "The operation of these MAPI components is illustrated by describing the flow of an electronic message through these components. The user of a client application 300 sends an electronic message to one or more recipients. A message store provider 330 initiates the sending process and formats the message with additional information needed for transmission. The MAPI spooler 310 receives the electronic message, performs any required preprocessing, and delivers it to the appropriate transport provider 340."[9]

The applicant respectfully points out that nowhere in the cited reference (nor in its entirety) does Shuman disclose the reception of a "folder registration request" from a "message application." The Examiner asserted that "the folder registration request is illustrated by the electronic messages, which are requests . . . ."[10] However, the Applicants respectfully submit that a "folder registration request" is in no way inherently disclosed by an electronic message being sent by an application. It is entirely possible for an electronic message to be sent (and received) without any folder registration request being sent or received. A folder registration request is a particularity which is in no way universal to all messaging systems. Shuman, itself, teaches that the "operating system incorporates the Messaging Application Programming Interface (MAPI)," and, as such, the "underlying messaging system is completely transparent."[11] Because Shuman teaches that MAPI is incorporated into its operating system and because the "underlying messaging system is completely transparent"[12] its internal functionality is unknowable to both the user and to the Examiner and it would be improper to conclude, as does the Examiner, that "the folder registration request is illustrated by the electronic message." Because of the architecture taught by Shuman,

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[6] *See* claim 1; *see also*, claim 25.
[7] *See* claim 1.
[8] Office Communication p. 7 (Mar. 14, 2007).
[9] Shuman col. 9 l. 44–49.
[10] Office Comm. p. 7.
[11] Shuman col. 7 l. 59 – col. 8 l. 6.
[12] Shuman col. 7 l. 59 – col. 8 l. 6.

the underlying operations of the operating system cannot be known. The Applicants point out that it is the Examiner's duty, if he so asserts, to provide rationale or evidence which shows that a "folder registration request" is inherently illustrated (as is apparently asserted) by the sending of an electronic message.[13] The Applicants submit such teaching is not inherent in Shuman and respectfully request the Examiner to provide the requisite rationale or evidence to illustrate why the cited portion of Shuman inherently discloses a "receiving a folder registration request."

The Examiner cited Shuman col. 9 l. 11–19 for teaching an "operating system determining that a folder silo has resources available to satisfy the folder registration request."[14] The portion of Shuman cited by the Examiner is reproduced here:

> "Message store providers 330 handle the storage and retrieval of electronic messages and other information for the users of a client application. As illustrated in FIG. 4, the message information is organized using a hierarchical system known as a message store, which is implemented in multiple levels, with containers called folders holding electronic messages of different types. There is no limit to the number of levels in a message store, and folders can contain many sub-folders."[15]

The Examiner asserted that "the preceding text clearly indicates that a folder silo is illustrated by the function of the message store providers that *determine the resource availability* to satisfy a request."[16] Firstly, nowhere does the above citation disclose that the "message store providers *determine . . . resource availability*." The Applicants respectfully submit that the cited portion of Shuman (as well as its entirety) fails to teach any determination of resources available to satisfy a folder registration request. The cited portion of Shuman discloses a message store which is organized using a hierarchical system but nowhere is it taught that it is determined if resources are available. The Applicants point out that disclosing a data store and disclosing the particular structure of a data store does not inherently disclose the function of determining if the data store has sufficient resources. A "message store," as disclosed above, may be empty or full but the above citation nowhere discloses any function to determine if the store is empty, full, or otherwise has resources available. If the Examiner is asserting that the function of determining if resources are available is inherently disclosed by the portion of Shuman cited by the Examiner, the

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[13] MPEP § 2112.
[14] Office Comm. p. 7.
[15] Shuman col. 9 l. 11–19.
[16] Office Comm. p. 7 (emphasis added).

Applicants respectfully request that the Examiner provide the requisite rationale or evidence showing inherency as demanded by the MPEP.[17]

The Examiner cited Shuman col. 9 l. 11–19 (quoted above) and col. 9 l. 28–40 for teaching "*maintaining an indication* that the *message application has primary control* of the allocated folder space such that other applications may be made aware that the message application has primary control . . . ."[18] The additional citation is provided here:

> "Transport providers 340 handle message transmission and reception. They control the interaction between the MAPI spooler 310 and the underlying messaging system 320. They also implement security if necessary and take care of any pre-processing and post-processing tasks that are required. Client applications 300 communicate with the transport providers 340 through a message store provider 330. When an incoming message is detected, the transport provider informs the MAPI spooler and the message is delivered to the appropriate message store. To handle outgoing messages, the message store moves the message to the outbound queue, informs the MAPI spooler, and the spooler transfers it to the appropriate transport providers."[19]

The Examiner asserted that "the preceding text clearly indicates that the transport providers make aware that the message application has primary control."[20] The Applicants respectfully submit that the cited portions of Shuman (as well as its entirety) fail to disclose maintaining an indication that the message application has primary control of the allocated folder space. It is entirely consistent with the above cited portions of Shuman that the "message store provider" has primary control of the "message store" which contains folders and electronic messages. That is in contrast to the present invention in which the message application (not the message store provider) has primary control of the folder silo. Further, the above cited portions of Shuman (as well as its entirety) fail to teach that an indication (of control) is maintained. If the Examiner is asserting that the above cited portions of Shuman inherently disclose "*maintaining an indication* that the *message application has primary control*," the Applicants respectfully request that the Examiner provide the requisite rationale or evidence as demanded by the MPEP.[21]

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[17] MPEP § 2112.
[18] Office Comm. p. 8.
[19] Shuman col. 9 l. 28–40.
[20] Office Comm. p. 8.
[21] MPEP § 2112.

A rejection under 35 U.S.C. § 102 requires that each and every element of a claim must be found within a single reference.[22] As discussed above, there are particular elements of claim 1 which are clearly never taught, explicitly or implicitly, by Shuman. If the Examiner asserts that particular elements of the claim are inherent in the teachings of Shuman, then the Applicants respectfully request that the Examiner provide the requisite rationale or evidence of such inherency.[23] For an element to be inherent, there may be no possible interpretation of the cited art such that the element is not included, that is, "the allegedly inherent characteristic *necessarily flows* from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis added). The fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). As such, Applicants submit that a rejection of claim 1 under 35 U.S.C. § 102 is without sufficient basis, has not been adequately supported by the Examiner and should be considered improper.

In view of the foregoing, the Applicants respectfully request the rejection of claim 1 be withdrawn and submit that claim 1 is in condition for prompt allowance. Applicants now respectfully request the allowance of claim 1. Claim 25 recites a system embodiment similar to the method recited in claim 1. As such, the discussion, above, applies equally to claim 25 and the Applicants respectfully request the rejection of claim 25 be withdrawn and, accordingly, request the allowance of claim 25.

In view of the foregoing, Applicants respectfully submit that rejections to the dependent claims are now moot and do not, therefore, need to be addressed individually at this time. However, the Applicants submit that the rejections of the dependent claims are also without proper basis or support. For example, in reference to claim 10, the Examiner cites only to Shuman Figures 3 & 4 for teaching "the operating system maintaining an indication that the message application has primary control of the allocated folder space comprises an act of updating an external list that tracks which message folders are allocated to which message applications."[24] Neither Shuman Figure 3 nor Figure 4 shows "an external list" or "an operating system updating" such a list. In another example, in reference to claim 11, the Examiner cites only to Shuman

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[22] MPEP § 2131.
[23] MPEP 2112.
[24] Office Comm. p. 11.

Figure 3 for teaching "the operating system maintaining an indication that the message application has primary control of the allocated folder space comprises an act of altering the arrangement of the folder silo such that subsequent analysis of the folder silo indicates that the folder space is allocated to the message application."[25] Shuman Figure 3 shows only a structure and discloses no "altering the arrangement of the folder silo" whatsoever. In both of these examples, the cited portion of Shuman fails to teach the elements of the claim and the Examiner has failed to cite any rationale or evidence that the elements of the claims are inherent to that which Shuman does disclose.
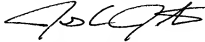
As discussed above, the remaining rejections of the dependent claims are made moot by the lack of proper and adequate support for rejection of the independent claims. It will be appreciated, however, that this should not be construed as Applicants acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicants reserve the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicants specifically request that the Examiner provide references supporting the teachings officially noticed, as well as the required motivation or suggestion to combine the relied upon notice with the other art of record.

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[25] Office Comm. p. 11.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 14th day of May, 2007.

Respectfully submitted,

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